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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM O. CAMP, JR. and DANIEL P. HOMILLER

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Appeal 2009-002467  
Application 10/783,601  
Technology Center 2600

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Decided: September 24, 2009

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Before JOHN C. MARTIN, MAHSHID D. SAADAT, and ROBERT E.  
NAPPI, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the rejection of claims 1 through 32.

We affirm.

## INVENTION

The invention is directed to a portable electronic device with a thumb operable input device on the side of the housing. See pages 1, 2 and Figs. 2, 4, 5A, 5B, 6, and 7 of Appellants' Specification. Claim 1 is reproduced below:

1. A portable electronic device, comprising:
  - a housing;
  - a display integrated with the housing;
  - a thumb-operable input device positioned on a side of the housing;
  - an indicator on the display operatively associated with the thumb-operable input device, the indicator being positioned on the display to highlight and/or select menu items on the display responsive to input received at the thumb-operable input device.

## REFERENCE

Frederiksen	US 6,570,596 B2	May 27, 2003
Canova, Jr.	US 2003/0137495 A1	Jul. 24, 2003
Brosnan	US 6,977,645 B2	Dec. 20, 2005
Poloniemi1	EP 1113385 A2	Jul. 4, 2001

### REJECTION AT ISSUE

The Examiner has rejected claims 1, 6 through 13, 25, 26, and 29 through 32 under 35 U.S.C. § 103(a) as being unpatentable over Canova in view of Brosnan. The Examiner's rejection is on pages 3 through 5 of the Answer.<sup>1</sup>

The Examiner has rejected claims 2, 14, and 18 through 24 under 35 U.S.C. § 103(a) as being unpatentable over Canova in view of Brosnan and Frederiksen. The Examiner's rejection is on pages 5 through 7 of the Answer.

The Examiner has rejected claims 3 through 5, 15 through 17, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Canova in view of Brosnan and Poloniemi. The Examiner's rejection is on pages 7 through 8 of the Answer.

### ISSUES

Appellants argue on pages 4 through 7 of the Brief<sup>2</sup> that the Examiner's rejection of independent claims 1, 13, and 25 under 35 U.S.C. § 103(a) is in error. Appellants argue that the combination of the references do not disclose or suggest a thumb-operable input device on the side of an electronic device's housing which positions an indicator on display as recited in claim 1. Br. 4-6. Further, Appellants argue that there is no motivation to suggestion to combine the references as suggested by the Examiner. Br. 6-7.

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<sup>1</sup> Throughout the opinion we refer to the Answer mailed January 23, 2008.

<sup>2</sup> Throughout the opinion we refer to the Brief dated November 26, 2007.

Thus, Appellants' contentions directed to the rejection of claims 1, 6 through 13, 25, 26, and 29 through 32 under 35 U.S.C. § 103(a) present us with the following issues:

1) Have Appellants shown that the Examiner erred in finding that the combination of the references teaches an electronic device with a thumb-operable input device which allows for positioning of an indicator on a display as recited in claim 1?

2) Have Appellants shown that the Examiner erred in combining the teachings of Canova and Brosnan?

*Rejections of claims 2 through 5, 14 through 24, 27 and 28*

Appellants argue on page 7 of the Brief that these claims depend upon one of independent claims 1, 13, and 25 and are patentable for the reasons discussed with respect to the independent claims. Accordingly, Appellants argue that the rejections of claims 2 through 5, 14 through 24, 27, and 28 are in error for the reasons discussed with respect to claim 1.

Thus, for the rejections of these claims we are presented with the same issues as claim 1.

## PRINCIPLES OF LAW

On the issue of obviousness, the Supreme Court has recently stated that "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.*

at 416. “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of the invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *Id.* at 419-420.

### FINDINGS OF FACT

1. Canova teaches a system for inputting text information into a handheld computer, such that the graffiti area (area for inputting hand written text) can be displayed in response to selection of a switch. Abstract, Para 0002.
2. The switch for turning on the display of the graffiti area is labeled item 119 in the Figures. Canova, para. 0027.
3. Canova teaches several embodiments where the switch is mounted at various locations on the hand held computer. In the embodiments of Figures 3 and 4 the switch is on a side of the computer housing which is perpendicular to the side that includes the display. In the embodiments of Figures 6, 7, and 9, the switch is on the side of the computer housing which includes the display. Para 0033.
4. Canova teaches that placing the button on the side of the device perpendicular to the side that includes the display allows the user to hold the device in one hand and actuate the switch with their thumb. Paras. 0036 and 0038
5. Brosnan teaches a portable electronic device which includes a menu display. The electronic device includes a motion sensor which is used as an input device to generate motion data which is used to move a menu pointer. Abstract.

6. The menu pointer takes the form of highlighting menu items.  
Brosnan, col. 2, ll. 28-38.
7. Brosnan teaches that the motion detection device 20 can be mounted on the same side of the display (i.e. front side) or on the side parallel and behind the side with the display (i.e. back side). See Figures 1A and 1B. Col. 5, ll. 27-35.
8. The motion detection device is made to be actuated by user's finger.  
Brosnan, col. 5, ll. 45-50.

### ANALYSIS

#### First issue.

Appellants have not persuaded us that the Examiner erred in finding that the combination of the references teaches an electronic device with a thumb-operable input device which allows for positioning of an indicator on a display as recited in claim 1. Claim 1 recites an electronic device with a housing, a display within the housing, and a thumb-operable input device on a side of the housing. Claim 1 does not recite which side of the housing the display is mounted on, thus, claim 1 does not preclude the display and the input device from being on the same side of the display. Claim 1 further recites that the display has an indicator where "the indicator being positioned on the display to highlight and/or select menu items on the display responsive to input received at the thumb-operable input device." Thus, claim 1 requires that the display includes an indicator which highlights or selects a menu item.

The Examiner in rejecting claim 1 finds that Canova teaches a computer with a display and a thumb-operable input device on the side of the housing. Answer 3. We find ample evidence to support the Examiner's

findings. Facts 1, 2, and 4. Further, the Examiner finds that Brosnan teaches a hand held computer with a finger actuated input device and a display with menu items that a user selects by highlighting a particular menu item. Answer 3. We find ample evidence to support these findings by the Examiner. Facts 5, 6, and 8.

Appellants' arguments on page 5 of the Brief focus on Canova's teaching that the switch operates or deactivates a text entry area and not highlighting or selecting menu items as claimed. This argument has not persuaded us of error in the Examiner's rejection as the Examiner has relied upon Brosnan for this teaching. Further, Appellants' arguments directed to Brosnan on page 6 of the Brief focus on Brosnan's teaching of mounting the finger actuated input device on the front and not the side of the computer device. We are similarly not persuaded by this argument as the Examiner relied upon Canova for teaching that an input device can be mounted on the side of a computer device. Further, as discussed above, claim 1 does not identify that the thumb actuated device and display are mounted on different sides of the device, as such the scope of the claim is broad enough to encompass the display and the thumb actuated input device being are on the same side of the device. Thus, applying this claim interpretation, we also find that Brosnan teaches that the finger actuated input device is on the side of the computer housing. Fact 7.

For the above reasons, Appellants' arguments have not persuaded us that the Examiner erred in finding that combination of the references teaches an electronic device with a thumb-operable input device which allows for positioning of an indicator on a display as recited in claim 1.



Second issue.

Appellants' arguments have not persuaded us that the Examiner erred in combining the teachings of Canova and Brosnan. Appellants' arguments on page 7 of the Brief assert that the motivation to combine the references comes from hindsight reasoning. The Examiner states on page 9 of the Brief, that combining Canova's teaching of a thumb input with "Brosnan's highlighting or menu selection function would provide one skill[ed] in the art with more visibility and easy to see the selected item on the display." We concur with the Examiner's rationale. We further note that combining the teachings of the references represents nothing more than applying known solutions to known problems. Canova teaches that placing an input device on the side perpendicular to the display (a narrow interpretation of the claimed thumb input device) is to allow the user to actuate the switch and hold the device with one hand. Fact 4. As such one skilled in the art would recognize that moving the input device, item 20 of Brosnan, to the side perpendicular to the display would provide the same benefit, allowing the user to actuate the input device one handed. Thus, Appellants' arguments have not persuaded us that the Examiner erred in concluding that a skilled artisan would combine the teachings of Canova and Brosnan.

*Rejection of claims 1, 6 through 13, 25, 26, and 29 through 32 under 35 U.S.C. § 103(a).*

Appellants' arguments directed to this rejection grouped all of the claims with claim 1 and presented us with two issues. As Appellants' arguments directed to these issues have not persuaded us of error in the Examiner's rejection of claim 1, we sustain the Examiner's rejection of

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claims 1, 6 through 13, 25, 26, and 29 through 32 under 35 U.S.C. § 103(a)  
as being unpatentable over Canova in view of Brosnan.

*Rejections of claims 2 through 5, 14 through 24, 27, and 28 under 35  
U.S.C. § 103(a).*

Appellants' arguments directed to these rejections rely upon the  
arguments presented with respect to claim 1. As Appellants' arguments  
directed to claim 1 have not persuaded us of error in the Examiner's  
rejection of claim 1, similarly we sustain the Examiner's rejection of claims  
2 through 5, 14 through 24, 27, and 28 under 35 U.S.C. § 103(a).

#### CONCLUSION

Appellants have not persuaded us of error in the Examiner's rejection  
of claims 1 through 32.

#### ORDER

The decision of the Examiner to reject claims 1 through 32 is  
affirmed.

No time period for taking any subsequent action in connection with  
this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

ELD

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